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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,181	08/31/2000	Simona Cohen	6727/0H608	4228
7590	01/07/2005		EXAMINER	
S Peter Ludwig Darby & Dary PC 805 Third Avenue New York, NY 10022			PARK, CHAN S	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/653,181	COHEN, SIMONA
	Examiner	Art Unit
	CHAN S PARK	2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 August 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 12-19,31-38 and 40 is/are allowed.
- 6) Claim(s) 1-11,20-30 and 39 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 8/12/04, and has been entered and made of record. Currently, **claims 1-40** are pending.

Response to Arguments

2. Applicant's arguments filed 8/12/04 have been fully considered but they are not persuasive.

In response to applicant's argument regarding the rejection of **claim 1**, wherein on pages 2 and 3, the applicant explains how the current invention differs from the teaching of Scott. Particularly, the applicant states that the current invention has, for example, a method for transmitting a fill page, wherein the fill page is an entire page, into which the gateway may insert substantially any type of content. Additionally, the applicant points out that the method causes the second terminal to print the fill page, but has no effect on the pages of actual facsimile images that are transmitted between the facsimile terminals before or after the fill page, regardless of how long the delay in receiving the signal. The applicant further points out that the fill pages may be added whenever desired, without affecting the quality of actual facsimile images. The examiner agrees with the applicant, in that the process performed by the current invention is different than what Scott teaches. However, these differences are not apparent in the current claim wording. It is noted that the features upon which applicant relies (i.e., fill page is an entire page and can be added whenever desired, without

affecting the quality of actual facsimile images) are not recited in the rejected claim.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Scott teaches a method of sending either fill data or stall data to a destination facsimile to prevent protocol timeouts and a method of printing the data at the destination (acknowledged by the applicant). When the facsimile gateway (destination FIU 14-2) has not received a page data to be transmitted to the destination facsimile (destination FTE 10-2), the page data is *filled with white scan lines* by the gateway and transmitted to the destination facsimile to be printed (col. 7, line 62 – col. 8, line 27). Thus, Scott clearly teaches the method of inserting/adding substantially any type of content, as it is required in claim 1 according to the applicant's argument (remarks, page 3, lines 1-2).

Therefore, the rejections of **claim 1** and its dependent **claims 2-7 and 9-11**, as cited in the Office action dated 5/19/04, under 35 U.S.C. 102(e) as being anticipated by Scott, are maintained and repeated in this Office action.

Claim 20 recites apparatus for facsimile transmission, while claim 39 recites a computer software product for facsimile transmission, both of which operate on principles similar to the method of claim 1. Thus, for the reasons stated above, the rejections of **claims 20 and 39** and their dependent **claims 21-26 and 28-30** are maintained and repeated in this Office action.

For the reasons stated above, the rejections of **claims 8 and 27**, as cited in the Office action dated 5/19/04, under 35 U.S.C. 103(a) over Scott in view of Endo, are also maintained and repeated in this Office action.

3. Applicant's arguments, see pages 4-7, filed 8/12/04, with respect to **claims 12-19, 31-38 and 40** have been fully considered and are persuasive. The rejections of the claims have been withdrawn.

Allowable Subject Matter

4. **Claims 12-19, 31-38 and 40 allowed.**

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 7, 9-11, 20-23, 25, 26, 28-30 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Scott U.S. Patent No. 6,339,481.

5. With respect to claim 1, Scott teaches a method for facsimile transmission over a packet network (fig. 4), comprising:

establishing a facsimile call between first (originating FTE 10-1) and second facsimile terminals (destination FTE 10-2) in accordance with a facsimile protocol, using a facsimile gateway (destination FIU 14-2) to convey communications between the terminals over the packet network (col. 9, lines 31-32);

awaiting arrival at the gateway of a signal conveyed over the packet network from the first terminal, to be transmitted from the gateway to the second terminal as provided by the protocol (col. 7, lines 53-61 & col. 8, lines 28-41);

transmitting a fill page from the gateway to the second terminal if the signal does not arrive within a time limit determined in accordance with the protocol (col. 7, lines 53-61 & col. 8, lines 28-41); and

receiving the signal at the gateway and transmitting the signal from the gateway to the second terminal after transmitting the fill page (col. 7, lines 53-61 & col. 8, lines 28-41).

6. With respect to claim 2, Scott teaches a method according to claim 1, wherein the facsimile protocol comprises a T.30 protocol of the International Telecommunications Union (ITU-T) (col. 1, lines 14-25).

With respect to claim 3, Scott teaches a method according to claim 2, wherein the packet network operates in accordance with an Internet Protocol (IP) (col. 4, lines 1-4).

7. With respect to claim 4, Scott teaches a method according to claim 3, wherein establishing the facsimile call comprises establishing a real-time fax over IP connection (col. 1, lines 8-11 & col. 11, lines 36-37), and wherein transmitting the fill page comprises initiating a session fax mode of communication in response to a network

delay causing the signal to fail to arrive within the time limit (col. 7, lines 53-61 & col. 8, lines 28-41).

8. With respect to claim 6, Scott teaches a method according to claim 1, wherein the first terminal comprises a sending terminal, and the second terminal comprises a receiving terminal, and wherein awaiting the arrival of the signal comprises awaiting transmission of a complete page of facsimile data from the sending terminal (col. 9, lines 7-18 & fig. 5 S5-1&2).

9. With respect to claim 7, Scott teaches a method according to claim 6, wherein the gateway comprises a receiving gateway linked to the receiving terminal by a telephone line (col. 1, lines 14-16 & col. 4, lines 18-28), and wherein awaiting the transmission of the complete page comprises awaiting the transmission of the complete page by a sending gateway (originating FIU 14-1 in fig. 4) linked to the sending terminal.

10. With respect to claim 9, Scott teaches a method according to claim 1, wherein the first terminal, and the second terminal comprises a sending terminal, which sends at least one page of facsimile data to the receiving terminal over the packet network using the facsimile gateway during the facsimile call, and wherein awaiting the arrival of the signal comprises awaiting a notification of delivery of the at least one page to the receiving terminal (col. 2, lines 26-41 & figs. 2 and 4).

11. With respect to claim 10, Scott teaches a method according to claim 9, wherein transmitting the fill page comprises instructing the sending terminal to perform a line turnaround in order to receive the fill page (col. 2, lines 26-41 & fig. 2).

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12. With respect to claim 11, Scott teaches a method according to claim 9, wherein the at least one page of facsimile data comprises first and second pages of facsimile data (the second to last page and the last page), and comprising transmitting a confirmation signal (S16) from the gateway(originating FIU 14-1) to the sending terminal after receiving the first page from the sending terminal at the gateway, responsive to which the sending terminal sends the second page to the gateway (step after S16 “page data starts”), before receiving a confirmation packet at the gateway over the network indicating that the first page was received at the receiving terminal (fig. 4).

13. With respect to claim 20, arguments analogous to those presented for claim 1, are applicable.

14. With respect to claim 21, arguments analogous to those presented for claim 2, are applicable.

15. With respect to claim 22, arguments analogous to those presented for claim 3, are applicable.

16. With respect to claim 23, arguments analogous to those presented for claim 4, are applicable.

17. With respect to claim 25, arguments analogous to those presented for claim 6, are applicable.

18. With respect to claim 26, arguments analogous to those presented for claim 7, are applicable.

19. With respect to claim 28, arguments analogous to those presented for claim 9, are applicable.

20. With respect to claim 29, arguments analogous to those presented for claim 10, are applicable.
21. With respect to claim 30, arguments analogous to those presented for claim 11, are applicable.
22. With respect to claim 39, arguments analogous to those presented for claim 1, are applicable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott.

23. With respect to claim 5, Scott teaches a method according to claim 4, but Scott does not teach expressly that an ITU-T T.38 protocol is used in the real-time fax over IP connection.

However, Examiner takes Official Notice that establishing the connection in accordance with an ITU-T T.38 protocol in the real-time fax over IP connection is well known in the Internet and network facsimile art. Examiner further provides U.S. Patent No. 6,381,038 of Endo as an example to support such an argument.

It would have been obvious at the time the invention was made to one of ordinary skill in the art to use an ITU-T T.38 protocol in the real-time fax over IP connection in the Scott facsimile device since Examiner takes Official Notice that establishing the connection in accordance with an ITU-T T.38 protocol in the real-time fax over IP connection is well known in the Internet and network facsimile art.

24. With respect to claim 24, arguments analogous to those presented for claim 5, are applicable.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scott as applied to claim 1 above, and further in view of Endo U.S. Patent No. 6,381,038.

25. With respect to claim 8, Scott teaches a method according to claim 1, but Scott does not teach expressly the method comprising awaiting arrival of a training message indicative of capabilities of the first terminal and conveyed over the packet network from the first terminal, and if the training message does not arrive within a training time limit determined in accordance with the protocol, initiating a default training sequence between the gateway and the second terminal, substantially independently of the capabilities of the first terminal.

Endo, on the other hand, teaches a method for facsimile transmission over a packet network (fig. 15), comprising:

establishing a facsimile call between first (calling facsimile machine 113) and second facsimile terminals (called facsimile machine 123) in accordance with a facsimile protocol, using a facsimile gateway (called-side gateway 223) to convey

communications between the terminals over the packet network (col. 26, lines 25-51); and

awaiting arrival at the gateway of a signal conveyed over the packet network from the first terminal, to be transmitted from the gateway to the second terminal as provided by the protocol (col. 26, lines 25-51).

Additionally, Endo teaches a method comprising awaiting arrival of a training message indicative of capabilities of the first terminal and conveyed over the packet network from the first terminal, and if the training message does not arrive within a training time limit determined in accordance with the protocol, initiating a default training sequence (RNR and RR) between the gateway and the second terminal, substantially independently of the capabilities of the first terminal (col. 30, lines 35-44).

Scott and Endo are analogous art because they are from the same field of endeavor that is network facsimile communication art using gateway devices.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to implement the method of initiating a default training sequence between the gateway and the second terminal of Endo into the Internet facsimile device having the fill page method of Scott.

The suggestion/motivation for doing so would have been to keep the connection alive and active even when there is a delay between the two gateways.

Therefore, it would have been obvious to combine Scott and Endo to obtain the invention as specified in claim 8.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scott as applied to claim 20 above, and further in view of Endo.

26. With respect to claim 27, arguments analogous to those presented for claim 8, are applicable.

Conclusion

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park
Examiner
Art Unit 2622

csp
January 5, 2005



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